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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,706	12/30/2003	Mark Lester	1671-0278	2131

28078 7590 10/24/2005

MAGINOT, MOORE & BECK
BANK ONE CENTER/TOWER
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INDIANAPOLIS, IN 46204

EXAMINER

SNOW, BRUCE EDWARD

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 10/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/748,706

Applicant(s)

LESTER ET AL.

Examiner

Bruce E. Snow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-5, 7-18 is/are rejected.
- 7) ☒ Claim(s) 2,3 and 6 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/24/5; 9/16/5.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Allowable Subject Matter

Claims 2-3 and 6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Specification

The specification is objected to for not containing :

- (h) Brief Description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "head" in claims 13-18 is used by the claim a portion of the "body 11", while the accepted meaning is the ball portion only. The term is indefinite because the specification does not clearly redefine the term.

Claims 13-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13, *"head including a surface defining a mechanical engagement feature configured to engage a complementary feature formed in a removed portion of the articulating aspect of the bone"* is ambiguous. Applicant's specification clearly teaches the mechanical engagement feature is located on the body 11 and not the head.

Regarding claims 12 and 17, at least one screw and screw bore defined in the implant/head is understood. Please direct to specification and drawings for this configuration.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 4-5, 8-10, 13-14, 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Lee et al (3,939,498).

Lee teaches a method for repair of a joint comprising the steps of:
removing a portion of a bone 53 having natural soft tissue attached thereto;
implanting an implant 10 within the remaining bone leaving an exposed surface of the implant;
preparing a surface of the removed portion of bone to provide the surface with a surface feature (bore 54) to mechanically interlock with a complementary feature (member 20) defined on the exposed surface of the implant', and
mechanically engaging the surface feature of the removed portion of bone with the complementary feature of the implant when the implant is within the remaining bone while the natural soft tissue is still attached to the removed portion of bone.

Regarding claim 10, mechanical fastener, see fastener 40.

Regarding claims 13-18, as far as the scope can be determined, the following is made of record:

Claim 13: stem 13, body 10, mechanical engagement feature 14 or 20. Note that the slot can be used to accept a complementary feature formed in the trochanter. Said opening has "diverging opposing faces" which contain the enlarged end portion 22.

Claims 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Caldarise et al (6,008,431).

Caldarise et al teaches an implant comprising:

A stem 25 configured for implantation in a bone of a joint; and
a head configured to replace a portion of the articulating aspect of the bone, said head including a surface 28 defining a mechanical engagement feature configured to engage a complementary feature formed in a removed portion of the articulating aspect of the bone. Regarding the dovetail, see figure 2.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7, 11, 12, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al (3,939,498) in view of Harwin (5,163,961) and/or Galline et al (4,889,110).

Lee et al teaches the implant as taught above, however, is silent regarding additional anchoring means of the trochanter. Harwin teaches an screw 9 and hole 10a and Galline et al teaches cerclage cable. It would have been obvious to one having ordinary skill in the art to have utilized either/both of the screw and cable as taught in the art or bone cement which is well known in the art to provide additional anchoring of the implant as deemed necessary by the surgeon.

Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caldarise et al (6,008,431) in view of Harwin (5,163,961) and/or Galline et al (4,889,110).

Caldarise et al teaches the implant as taught above, however, is silent regarding additional anchoring means. Harwin teaches an screw 9 and hole 10a and Galline et al teaches cerclage cable. It would have been obvious to one having ordinary skill in the art to have utilized either/both of the screw and cable as taught in the art or bone cement which is well known in the art to provide additional anchoring of the implant as deemed necessary by the surgeon.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce E. Snow whose telephone number is (571) 272-4759. The examiner can normally be reached on Mon-Thurs.

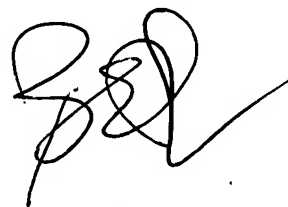
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

bes

A handwritten signature in black ink, appearing to read 'BSN', with a long horizontal stroke extending to the right.

BRUCE SNOW
PRIMARY EXAMINER